

REMARKS

Claims 1-67 are pending herein. By the Office Action, claims 4-5, 9-17 and 32-66 are withdrawn from consideration; the specification is objected to; claim 67 is rejected under 35 U.S.C. §112; claims 1-3, 6, 18-21, 24-25, and 28 are rejected under 35 U.S.C. §102(b); and claims 1-3, 6 and 18-31 are rejected under 35 U.S.C. §103(a). By this Amendment, claims 1, 6, 34 and 43 are amended. No new matter is added.

Entry of this Amendment is proper under 37 C.F.R. §1.116 because the Amendment places the application in condition for allowance (for the reasons discussed herein) or places the application into better form for Appeal should an Appeal be necessary. The Amendment does not present any additional claims without canceling a corresponding number of finally rejected claims, does not raise the issue of new matter, and does not raise any new issues requiring additional search and/or consideration since the Amendment is directed to subject matter previously considered during prosecution. Furthermore, the amendments are necessary and were not earlier presented because they are in response to issues raised in the Final Rejection. Applicants respectfully request entry of the Amendment.

Applicants thank the Examiner for the indication that claims 7 and 8 are objected to only for being dependent upon a rejected base claim, but are otherwise allowable. For all of the reasons set forth below, the claims are in condition for allowance.

I. Information Disclosure Statement

An Information Disclosure Statement with Form PTO-1449 was filed on January 7, 2002. Although Applicants received initialed copies of the Forms PTO-1449, one reference was not initialed as having been considered of record. In particular, on page 3 of 4, the Examiner did not initial or otherwise refer to the Mimura non-patent reference. The Examiner is requested to initial and return to the undersigned a copy of the subject Form PTO-1449. For the convenience of the Examiner, a copy of that form is attached.

## II. Restriction Election

Claims 4-5, 9-17 and 32-66 are withdrawn from consideration as subject to a Restriction and Election of Species Requirement.

### A. The Restriction Requirement Should be Withdrawn

Applicants respectfully submit that the Restriction Requirement should be withdrawn, at least because rejoinder will be required. As Applicants' previously stated, Group I is directed to a composition. Group II is directed to a method of making the composition of Group I, and Group III is directed to a method of using the composition of Group I.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.*

In the present application, the method claims of Groups II and III include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Groups II and III, since at least claims 32 (Group II) and 65 (Group III) depend directly from claim 1.

Since the method claims of Groups II and III include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

B. Election of Species Requirement

Applicants thank the Examiner for the indication that the search within the species of Group I has been expanded, since tetrahydrocurcumin was not found. Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

III. Objection to Specification

The specification and previous amendment to the specification are objected to as introducing new matter under 35 U.S.C. §132. In particular, the Office Action objects to the specification amendment specifying that "[p]referably, according to one embodiment of the present invention, a composition of this invention has from 65 to 99.9 weight % of monomer such as cyanoacrylate or blend of cyanoacrylates and is promoted to polymerize by 0.005 to 10 weight % of an initiator or accelerator." Applicants respectfully traverse this objection.

The cited specification amendment arose from an incorporation by reference in the present specification. However, the Office Action argues that the incorporation by reference was for the specific, limited purpose of identifying suitable monomer species, but not for the weight percent content of the monomer species. Applicants disagree.

The subject new paragraph [0045.1] of the specification added in the previous Amendment was derived from U.S. Patent Application No. 09/919,877 filed August 2, 2001. That patent application was specifically incorporated by reference in the present application at paragraph [0044]. In particular, paragraph [0044] states in relevant part that "[s]uch alkyl ester cyanoacrylates and other suitable monomers are disclosed in, for example, U.S. Patent Applications Nos. 09/630,437, filed August 2, 2000, and 09/919,877, filed August 2, 2001, the entire disclosures of which are incorporated herein by reference." (Emphasis added.) Accordingly, the present specification did not merely incorporate a single passage of the cited

application, but instead incorporated the entire disclosure of the cited application. That entire disclosure included not only an identification of suitable monomers, but also the subject weight percent range. See also MPEP §2163.07(b).

Furthermore, even if the incorporation was only for the monomer species, a position which is completely incorrect, the subject weight percent ranges directly relate to the disclosure of suitable monomers. Accordingly, even if only the monomer disclosure was incorporated by reference, the disclosed weight percent ranges are part of the monomer disclosure, and must likewise be part of the incorporated material.

Accordingly, for at least these reasons, the present specification fully supports the added subject matter, at least by the incorporation by reference to the cited patent application. Reconsideration and withdrawal of the objection are respectfully requested.

#### IV. Rejection Under 35 U.S.C. §112

Claim 67 is rejected under 35 U.S.C. §112, first paragraph, for essentially the same reasons as in the objection to the specification, discussed above. However, for all of the above reasons, the subject matter of claim 67 was part of the original disclosure of the present application, and thus satisfied the requirements of 35 U.S.C. §112. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

#### V. §102 Rejection

Claims 1-3, 6, 18-21, 24-25, and 28 are rejected under 35 U.S.C. §102(b) over Miyami. Applicants respectfully traverse this rejection.

Miyami is cited as disclosing a composition that includes a vinyl resin solution, benzyl butyl phthalate, ethyl cyanoacrylate, tannic acid (a stabilizer) and tin fluoride. Tannic acid is alleged to be encompassed by the claimed extract of tea, as evidenced by Friedland. However, Miyami does not anticipate the claimed invention.

By this Amendment, claim 1 (and claim 34) is amended to exclude tannic acid, in the form of tea extract, from the scope of the claimed invention. Miyami does not disclose an adhesive composition comprising: a polymerizable 1,1-disubstituted ethylene monomer; and at least one stabilizer selected from the group consisting of herbal extracts, alpha- and beta-hydroxycarboxylic acids and salts thereof, ceramides, anti-inflammatories, vasoconstrictors, and mixtures thereof, wherein when the stabilizer is an herbal extract, it is selected from the specified group of compounds that does not include tannic acid or tea extract. At most, Miyami discloses only the use of various conventional stabilizers for stabilizing a cyanoacrylate component, but does not disclose the stabilizers of the claimed invention.

Accordingly, Miyami does not anticipate the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

#### VI. §103 Rejections

##### A. Miyami

Claims 1-3, 6 and 18-28 are rejected under 35 U.S.C. §103(a) over Miyami. Miyami is cited as described above. The Office Action then asserts that various limitations of the dependent claims would have been obvious over Miyami. Applicants respectfully traverse this rejection.

As described above, Miyami is cited as disclosing a composition that includes a vinyl resin solution, benzyl butyl phthalate, ethyl cyanoacrylate, tannic acid (a stabilizer) and tin fluoride. However, Miyami does not teach or suggest the claimed invention.

By this Amendment, claim 1 (and claim 34) is amended to exclude tannic acid in the form of tea extract from the scope of the claimed invention. Miyami does not teach or suggest an adhesive composition comprising: a polymerizable 1,1-disubstituted ethylene monomer; and at least one stabilizer selected from the group consisting of herbal extracts, alpha- and beta- hydroxycarboxylic acids and salts thereof, ceramides, anti-inflammatories,

vasoconstrictors, and mixtures thereof, wherein when the stabilizer is an herbal extract, it is selected from the specified group of compounds that does not include tannic acid in the form of tea extract, as claimed in claim 1.

At most, Miyami discloses only the use of various conventional stabilizers for stabilizing a cyanoacrylate component. However, Miyami does not teach or suggest the incorporation of at least one stabilizer into the composition, where the stabilizer is broadly selected from the claimed group consisting of specified herbal extracts, alpha- and beta-hydroxycarboxylic acids and salts thereof, ceramides, anti-inflammatories, vasoconstrictors, and mixtures thereof. Miyami does not teach or suggest that the disclosed and otherwise conventional stabilizers could or should be substituted by other compounds, without adversely affecting the stability and use of the composition.

Accordingly, Miyami would not have rendered obvious the claimed invention.  
Reconsideration and withdrawal of the rejection are respectfully requested.

B. Miyami and Papay

Claims 1-6 and 29-31 are rejected under 35 U.S.C. §103(a) over Miyami in view of Papay. Miyami is cited as described above. Papay is cited for its disclosure of the use of antioxidant stabilizers. The Office Action then asserts that various limitations of the dependent claims would have been obvious over Miyami and Papay. Applicants respectfully traverse this rejection.

As described above, Miyami is cited as disclosing a composition that includes a vinyl resin solution, benzyl butyl phthalate, ethyl cyanoacrylate, tannic acid (a stabilizer) and tin fluoride. Papay is cited for its disclosure of antioxidant stabilizers.

However, regardless of Papay's disclosure of antioxidant stabilizers, Papay does not overcome the deficiencies of Miyami, discussed above. Accordingly, any combination of Miyami and Papay would not have rendered obvious the claimed invention.

Accordingly, Miyami and Papay, alone or in combination, would not have rendered obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

**VII. Conclusion**

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

  
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Attachment:  
Form PTO-1449

Date: December 30, 2003

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DEPOSIT ACCOUNT USE  
AUTHORIZATION  
Please grant any extension  
necessary for entry;  
Charge any fee due to our  
Deposit Account No. 15-0461

Form PTO-1449 (REV. 8-83)		US Dept. of Commerce PATENT & TRADEMARK OFFICE	ATTY DOCKET NO. 108773	APPLICATION NO. 09/964,415	
INFORMATION DISCLOSURE STATEMENT  (Use several sheets if necessary)					
		APPLICANT(S) Ibraheem BADEJO et al.			
		FILING DATE September 28, 2001	GROUP 3731		
U.S. PATENT DOCUMENTS					
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS
		5,530,037	6/1996	McDonnell et al.	
		5,575,997	11/1996	Leung et al.	
		5,582,834	12/1996	Leung et al.	
		5,624,669	4/1997	Leung et al.	
		5,700,620	12/1997	Sakaguchi et al.	
		5,721,079	1/1998	Robello et al.	
		5,916,910	6/1999	Lai	
		5,928,611	7/1999	Leung	
		5,935,596	8/1999	Crotty et al.	
		5,985,300	11/1999	Crotty et al.	
FOREIGN PATENT DOCUMENTS					
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)					
		Mimura et al., "Method for Making Tetrahydrocurcumin and Substances Containing the Antioxidative Substance Tetrahydrocurcumin", 1993, 15 pp. (abstract only)			
EXAMINER				DATE CONSIDERED	
Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.					